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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,944	06/22/2001	Tetsuya Toshine	Q65162	6218

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05/02/2003

SUGHRUE, MION, ZINN, MACPEAK & SEAS
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EXAMINER

ANGEBRANNDT, MARTIN J

ART UNIT

PAPER NUMBER

1756

DATE MAILED: 05/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/885,944

Applicant(s)

TOSHINE ET AL.

Examiner

Martin J Angebrannt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 at line 8, the language "smaller than that between adjacent layers in other layers" is unclear and confusing. The examiner also wishes to point out that claim 7 recites a release sheet.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1,3,4 and 6 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Takeuchi et al. '857.

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Takeuchi et al. '857 in example B-1 describes a substrate separable by peeling from a protective layer, an embossed resin layer, a metal reflective holographic layer, a fragile layer and a heat sensitive adhesive layer. This corresponds to figure 4. Figures 8 and 9 shows a peel layer (61) on the lower adhesive layer (62) The examiner holds that the metal layer is the relief hologram layer. This interpretation is accepted in the art as evidenced by Kaule CA 2046711 at page 6 describing layer 18 as the embossed hologram layer. The relative softening points of the adhesive and the embossed resin layer are inherent as the medium does not come apart when applied.

6 Claims 1,3,4 and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeuchi et al. '857.

It would have been obvious to provide the lower adhesive layer of example B-1 or figures 4 or 5 with a peelable protective layer as shown in figures 8 and 9 to prevent inadvertent adhesion to undesired substrates. (Sticking it to something before it is ready or to something that it is not desired upon).

7 Claims 1,3,4 and 6 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Tahara et al. '048.

Tahara et al. '048 with respect to figure 12 describes a substrate (34) separable by peeling (35) from a protective layer (37), an embossed resin layer (6), a metal reflective holographic layer, a wavelength selective light blocking layer (11) and a heat sensitive adhesive layer (4) and an ink base information layer (3). This corresponds to figure 4. Figures 8 and 9 shows a peel layer (61) on the lower adhesive layer (62) The examiner holds that the metal layer is the relief hologram layer. This interpretation is accepted in the art as evidenced by Kaule CA 2046711 at

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page 6 describing layer 18 as the embossed hologram layer. The relative softening points of the adhesive and the embossed resin layer are inherent as the medium does not come apart when applied.

8 Claims 1,3,4 and 6 are rejected under 35 U.S.C. 102(e) as being fully anticipated by Heckenkamp et al. '752.

Heckenkamp et al. '752 with respect to figure 3, teaches a substrate (20) separable by peeling (21) from a protective layer (22), a thermoplastic layer (23), a metal reflective holographic layer (24), a protective layer (25) and a heat sensitive adhesive layer (26). (8/15-34).

The examiner holds that the metal layer is the relief hologram layer. This interpretation is accepted in the art as evidenced by Kaule CA 2046711 at page 6 describing layer 18 as the embossed hologram layer. The relative softening points of the adhesive and the thermoplastic layer are inherent as the medium does not come apart when applied.

9 Claims 1,3,4 and 6 are rejected under 35 U.S.C. 102(e) as being fully anticipated by, or in the alternative obvious over Hattori et al. '979.

Hattori et al. '979 with respect to figure 24e, teaches a substrate (44b) separable by peeling (44a1) from a protective resin layer (44a9), an adhesive layer (44a8), a metal reflective holographic layer (44a2), an interlayer (44a4) and a heat sensitive adhesive layer (44a3). (15/23-56). Useful adhesives including ethylene vinyl acetate, ethylene ethylacrylate, ethylene acrylic acid resins, etc. (23/25-46). The use of various holograms is disclosed. (24/1-67). The relative softening points of the adhesive layers are inherent as the medium does not come apart when applied.

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10 Claims 1-5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morii et al. '378.

Morii et al. '378 teaches laminates such as that of figures 6b, 10a, which comprise a protective layer (7), an adhesive layer (5"), a hologram layer (6), a second adhesive layer (5') and a removable substrate (see illustrative example 4, col. 27-28). The laminate of figure 10b, which comprise a protective layer (7), an adhesive layer (5"), a hologram layer (6), a second adhesive layer (5'), a reflective layer (9) a third adhesive layer (5) and a removable substrate (11). Useful volume holographic recording materials are disclosed. (12/28-16/35). Useful adhesive layer materials include acrylic, acetate, gelatin, casein, polyvinyl acetate and hot melt resins. (12/7-27 and 33/49-65). The surface of the surface protective layer (7) may be provided with a release layer and a rigid film initially adhered to it and then peeled from it. (18/33-52)

It would have been obvious to one skilled in the art to modify the invention of illustrative example by providing the surface protective layer with a release layer and a peelable substrate based upon the disclosure to do so.). The relative softening points of the adhesive layers are inherent as the medium does not come apart when applied.

11 Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morii et al. '378, in view of Kaule CA 2046711.

Kaule CA 2046711 teaches a holographic transfer film comprising a substrate (10), a separation layer (12), a protective film (14), an embossed layer (16), a metallic holographic layer (18), a protective layer (20) and an adhesive layer (22) and a peelable substrate (pages 5 and 6) The adhesive layer (22) may be colored black (page 6). The use of volume holographic materials, rather than embossed or relief holograms is disclosed. (page 6).

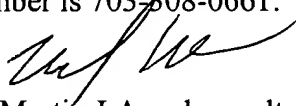
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It would have been obvious to one skilled in the art to modify the invention to use other type of holograms, such as relief holograms in the resultant embodiment of Morii et al. '378 discussed above, based upon the disclosure a equivalence by Kaule CA 2046711.

12 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J Angebrannndt whose telephone number is 703-308-4397. The examiner can normally be reached on Mondays-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 703-308-2464. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Martin J Angebrannndt
Primary Examiner
Art Unit 1756

April 29, 2003